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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/556,246    04/24/00    JAY    G    21486-026 CI

HM22/1002  
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EXAMINER

MITRA, R

ART UNIT

PAPER NUMBER

1653

DATE MAILED:

10/02/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trad marks**

# Office Action Summary

Application No.

09/556,246

Applicant(s)

JAY

Examiner

MITRA

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE one (1) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above, claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-54 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-29, 40, 41, drawn to tribonectins and fragments thereof and compositions which contain an O-linked lubricating moiety are for example classified in Class 530, subclass 350.
- II. Claims 30 and 31, drawn to polynucleotides encoding tribonectin is for example, classified in Class 536, subclass 23.5.
- III. Claims 32-39, and 42-49, drawn to a method of lubricating a joint (i.e., inhibiting adhesion formation between a first and second surface of a joint/tissue) with an megakaryocyte stimulating factor (MSF) gene product are for example, classified in Class 514, subclass 12 if the gene product is a protein but would be classified in Class 514, subclass 44 if the gene product is the primary expression product of the polynucleotide encoding MSF. Currently, this claim is interpreted for the purpose of restriction as reading on the gene product being a protein.
- IV. Claims 50-54, drawn to a method of diagnosis osteoarthritis or predisposition thereto by measuring the amount of MSF in a sample are for example, classified in Class 435, subclass 7.1.

In addition, each of Groups I through IV recite various forms of polypeptide or fragments thereof or a polynucleotide or fragments thereof. Each is distinct and/or independent one from the other because each has a different structure and function; and, no one reference, absent factual evidence to the contrary, have made any one polypeptide or any one polynucleotide anticipated or obvious. Thus, where one of Group I through IV is elected, applicant is also required to select one specific sequence of a polypeptide (Groups I, III, or IV) or one specific polynucleotide (Group II). This is not a species election. For completeness, applicant is requested to indicate the claims reading on the selected sequence.

The inventions are distinct, each from the other for the following reasons:

Inventions of Groups I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP 806.05(h)). In the instant case, the product of Group I can be used in a process of diagnosis of Group IV. In addition, Groups III and IV are alternative processes of use of the protein of Group I. Groups III and IV are

different processes which have different resultant outcomes and therefore, are distinct and/or independent one from the other.

Group I and II are different products, a protein and a polynucleotide. Each has different physical, chemical, and biological properties and functions. Neither one of these products are directly substitutable, one for the other. As to Group II, the processes of Groups III and IV do not use the product of Group II.

Because these inventions are distinct for the reasons given above and since they have acquired a separate status in the art as shown by their different classification and/or divergent subject matter, and/or are separately and independently searched, restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 C.F.R. 1.143).

Inquiry concerning this communication or earlier communications from the examiner should be directed to Rita Mitra whose telephone number is (703) 605-1211. If applicant is unable to contact the examiner, please contact the examiner's supervisor, Christopher Low, SPE AU 1653 at (703) 308-2923. Inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted by facsimile transmission to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1 (CM1) and must conform to the notice published in the Official Gazette, 1096 OG 30 (15 November 1989). The telephone number assigned to Art Unit 1804 in the CM1 PTO Fax Center is (703) 308-4242 or 305-3014.

RM   
1 Oct 2001



CHRISTOPHER S. F. LOW  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600